



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/991,113	12/16/97	UNDERYS	A FINKL-183-US

JAMES G. STAPLES ESQ
A. FINKL & SONS CO
2011 NORTH SOUTH PPORT AVENUE
CHICAGO IL 60614

IM22/0811

EXAMINER

WYSZOMIERSKI, G

ART UNIT	PAPER NUMBER
----------	--------------

1742

22

DATE MAILED:

08/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 08/991,113
Filing Date: December 16, 1997
Appellant(s): UNDERSYS

James G. Staples
For Appellant

EXAMINER'S ANSWER

MAILED
AUG 11 2000
GROUP 1700

This is in response to appellant's brief on appeal filed June 28, 2000

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement that no appeals and interferences exist which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

Art Unit: 1742

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

The examiner notes a slight inconsistency regarding claims 6-9. The Appeal Brief correctly states that these claims are rejected. Neither the first page of the final rejection (Paper no. 4) nor any of the subsequent Advisory Actions refer to these claims. However, the last sentence of paragraph no. 4 of the final rejection states that "...claims 15 and 16, and any claims dependent therefrom, are rejected..." [emphasis added], and this includes claims 6-9, which depend from claim 15. As both the examiner and Appellant acknowledge that these claims are rejected, this matter is considered resolved.

(4) Status of Amendments After Final

The amendments after final rejection filed on June 21 and August 10, 1999 (Paper nos. 6 and 9) have been entered. As pointed out by Appellant in the Brief, the paper entitled "Second Supplemental Amendment" (Paper no. 11), which does not include any amendments to the text of the specification but does include the "Declaration of Leonard Liuzzi" has been considered, as has the Letter filed May 23, 2000 (Paper no. 18).

(5) Summary of Invention

The summary of invention contained in the brief is correct.

Art Unit: 1742

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

However, with respect to issue (A), regarding tool steel "blocks", the examiner concedes that the evidence of record indicates that one of skill in the art would interpret the phrase "a 10" by 10" cross-section" (specification page 4, line 6) as describing a "block". The examiner specifically notes paragraph 7 of the first Brada Declaration (paper no. 5), and paragraphs 5-7 of the Liuzzi Declaration (paper no. 11).

Therefore, the sole remaining issue in this appeal is issue (B) on page 3 of the Brief, regarding workpieces "maintained stationary".

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 4, 6-9, and 15-17 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 4, 6-9, and 15-17 appears on pages 1 and 2 of the Appendix to the appellant's brief. The minor error is as follows: The Appendix includes a copy of claim 5, which was canceled by amendment filed March 19, 1999 (Paper no. 3).

Art Unit: 1742

(9) *Prior Art of Record*

The following is a listing of the prior art of record relevant to the present appeal.

<u>4</u> ,620,885	HEATH	11-1986
-------------------	-------	---------

The examiner notes that the above prior art is not being relied upon by the examiner in any rejection of the claims under appeal, but is discussed by Appellant in the Brief and will be commented upon herein.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 4, 6-9, and 15-17 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, nothing in the specification as originally filed indicated that one maintains a workpiece stationary during heat treatment from an infrared energy source. This feature is specifically recited in line 9 of appealed claims 15 and 16, which were added by amendment subsequent to the filing of the specification. Therefore, claims 15 and 16, and all claims dependent therefrom (claims 4, 6-9, and 17), are rejected under this statute.

(11) *Response to Argument*

On pages 14-21 of the Brief, Appellant alleges that the originally filed specification contained a disclosure of maintaining pieces of tool steel in a stationary position during heat

Art Unit: 1742

treatment, and/or that certain evidence presented during prosecution of this application indicates that a person of ordinary skill in the art would believe that the original specification refers to a process which includes such a “maintaining stationary” step as recited in the claims on appeal. The examiner respectfully disagrees, for the following reasons.

A) Original Disclosure

The original disclosure in the specification describes heat treating of tool steels. Page 3, lines 16-17 of the specification indicate that, in the process of the appealed claims, “existing heat treatment furnaces can be used with little or no modification, or, preferably, with selective modification.” Appellant’s position appears to be that one skilled in the art would recognize that workpieces of tool steel, particularly larger workpieces, are most readily and commonly treated in a furnace which maintains the workpieces stationary during treatment, and that therefore the “maintaining...stationary” language of appealed claims 15 and 16 would have been conveyed to one of skill in the art by the original disclosure.

However, clearly not all heat treatment furnaces process material in a stationary manner. This is exemplified by the Heath patent (U.S. Patent 4,620,884), which discloses the infrared treatment of metal parts in a furnace while the parts are moving through the furnace. While it would perhaps be impractical to treat large metal blocks in this manner, nothing in the instant claims limits the inventive process to the treatment of large metal blocks. In fact, the preambles of both independent claims 15 and 16 recite heat treating of bars, blocks, “and other tool steel workpieces”. This recitation of “other tool steel workpieces”, given its broadest

Art Unit: 1742

reasonable structural interpretation, indicates that the claimed process includes the treatment of very small individual pieces or cross sectional areas, where the easiest and most practical means of heat treatment may involve treatment in a moving or assembly line type process.

Next, the specification contains no literal support for the "maintaining...stationary" phrase. This phrase was not present in the original written specification. Therefore, Appellant can point to no specific language in the original specification to establish support for the presently claimed invention.

Given all of the above, it is clear that the specification, as originally filed, did not provide adequate support for a claim which recites maintaining a tool steel workpiece stationary, as required by both of the independent claims on appeal.

B) Declaration Evidence

The examiner initially notes that Mr. Guy A. Brada has submitted two declarations in this application (paper nos. 5 and 8). Neither of these declarations contain any information relevant to the sole issue in this appeal, and therefore no further comment will be made regarding the Brada declarations.

With regard to the Declaration of Leonard Liuzzi (Paper no. 11), Declarant states that, in his opinion, the phrase "heat treatment of tool steels" refers to a piece of equipment in which the workpieces are held stationary during treatment, that the reference to "existing heat treatment furnaces" at page 3, line 16 of the specification describes to Declarant a furnace in which the workpiece is maintained stationary, that Declarant has never heard of heat treating a

Art Unit: 1742

moving rod or bar, nor has Declarant ever heard of a movable ceramic support structure in a heat treat furnace, and stationary support structures can only be associated with stationary workpieces. First, the examiner notes that many of Declarant's statements are simply not correct, as evidenced by the disclosure in the Heath patent of the treatment of moving parts by infrared radiation in a furnace. Second, the mere fact that Declarant may not have ever heard of certain structures does not mean that such structures do not exist. Third, with reference to Declarant's statement that he has never heard of heat treating a moving rod or bar, even if correct this would not confer patentability upon the claims, because the claims are not limited to treatment of rods or bars, i.e. the claimed process can be performed upon any tool steel workpiece. Finally, the examiner submits that processes within the scope of the appealed claims and in which the pieces being treated are not stationary can easily be envisaged, particularly if one were treating small sized workpieces; arrangements in which metal is treated in a furnace similar in concept to a rotisserie grill or a microwave with a turntable would be examples of such treatments.

Declarant further states that the fact that a coating is needed in the furnace indicates to him that the workpiece is stationary, as the coating would be needed to prevent dangerous energy levels from accumulating at a single spot. This statement is not only speculative at best, but is contrary to what is stated at page 3, line 18 of the specification, i.e. that the purpose of the coating is "in order to concentrate the heat energy on to the tool steel".

Art Unit: 1742

Declarant also states that the reference in the specification to “time curves already formulated for two inch thick workpieces” (specification page 4, lines 4-5) can only refer to stationary workpieces since the already formulated time curves can refer only to time curves in existing stationary treatment furnaces. This statement employs circular logic on the part of Declarant; if one assumes that all existing furnaces are stationary treatment furnaces, then any already existing time curves can only refer to time curves obtained in stationary furnaces. The assumption is fallacious, however, as evidenced by the Heath patent.

C) Relationship between Heath patent, original rejection based upon prior art (Paper no. 2), and current rejection of appealed claims

On page 19 of the Brief, Appellant states that “the Examiner agreed that disclosure was originally made of workpieces being maintained stationary since he withdrew his prior art rejection which was based on a Heath patent showing heat treatment of moving steel” The examiner submits that Appellant is mischaracterizing the examiner’s views with this statement. The Heath patent was cited as prior art against a number of original claims in this application under 35 USC 102 or 103. None of these original claims contained any limitation regarding maintaining a workpiece stationary. Then, when confronted for the first time with claims which required that one maintain the workpiece stationary (i.e claim 15 and 16, filed with the amendment of March 19, 1999), the examiner reevaluated the rejections based upon prior art. It is well-settled that when evaluating claims for obviousness (e.g. under 35 USC 103), all

Art Unit: 1742

limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (*Ex parte Grasselli*, 231 USPQ 393). This practice is also official policy of the Patent Office; see MPEP section 2143.03. Clearly, if one gives weight to the limitation in the appealed claims that one maintains the workpieces stationary, then the Heath patent is not applicable prior art under 35 USC 102 or 103. This is completely irrelevant, however, to the issue of whether or not that limitation was disclosed in the application as filed. Once this limitation was introduced into the claims for the first time, the rejection based upon prior art was no longer tenable, but the fact that the limitation was being stated for the first time subsequent to the filing of the application resulted in the present rejection of the claims under 35 USC 112, first paragraph.

In summary, the examiner believes that the appealed claims were properly rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification as originally filed in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Affirmation thereof is solicited.

Art Unit: 1742

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP ~~1100~~
1760

GPW
August 2, 2000

Appeal Conference Held July 26, 2000

Participants Init:

GW
PJT
R-IL

James G. Staples, Esq.
A. Finkl & Sons Co.
2011 North Southport Avenue
Chicago, IL 60614